

Appl. No. 09/844,175
Response to Office Action mailed 4/10/2006

REMARKS

Applicants thank Examiner Nguyen for the courtesies extended to the undersigned during the telephone interview. An interview summary accompanies this response.

Applicants hereby add new claim 92 and cancel claims 90-91. Accordingly, claims 31-42, 54, 56-65, 67-70, and 75-89 and 92 are pending in the present application.

Claims 54-61, 64-65, 69-70, 76, 79-80, 83-84, and 87-88 are objected to. Claims 31, 33-34, 37-42, 62, 67-68, 75-79, 81-82, 85-88 and 90-91 stand rejected under 35 USC 102(b) for anticipation by U.S. Patent No. 4,937,653 to Blonder et al.

Applicants respectfully request reconsideration of the rejections.

Referring to the objections to the claims set forth on page 3 of the Action, Applicants have amended the independent claims 31, 54, 79 and 89 to clarify the recitation of semiconductor material. Applicants respectfully assert that the claims are clear and request withdrawal of the objection to the claims. The amendments made herein with respect to such claims now more positively express limitations which were previously inherent in such claims, and accordingly are not for the purpose of narrowing and do not effectively narrow the scope of any claim.

Referring to the objection to the claims which recite polyhedron and triangular prism, Applicants submit herewith dictionary definitions of polyhedron and prism from *Webster's Third New International Dictionary and Seven Language Dictionary* 1981. As set forth in the attached dictionary definition of polyhedron as "a figure or solid formed by plane faces," the exemplary embodiment of Fig. 6 definitely supports the claims reciting the apex or

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knife-edge line comprising a polyhedron. Furthermore, the attached definition of "prism" illustrates two forms of prisms including a triangular prism. Again, the exemplary embodiment of Fig. 6 definitely supports the claims reciting the apex or knife-edge line comprising a triangular prism. The Office has provided no support of the bald, cursory objection of the claims, nor has the Office has provided any rationale in support of the objection and contrary to the statements of the Office in the Notice of Allowance mailed December 2004 sanctioning the use of such language. Applicants respectfully submit objections of the claims which recite such limitations are improper in view of the attached dictionary definitions and at least the illustrative embodiment of Fig. 6 of the originally filed application.

Referring to the anticipation rejections of the claims over Blonder, Applicant notes the requirements of MPEP §2131 (8th ed., rev. 2), which states that TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM. The **identical invention** must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). **The elements must be arranged as required by the claim.** *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Regarding claim 31, Applicants again assert that Blonder does not anticipate the claimed removable electrical interconnect apparatus inasmuch as Blonder is clearly directed to establishing permanent connections. Applicants again assert that the rejection of claim 31 over Blonder is improper for the reasons set forth in the Office Action Response

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of Applicants filed on August 12, 2002 and as acknowledged by the Office as overcoming the rejections over Blonder by the subsequent withdrawal of such rejections.

Regarding the new Action, the Office alleges that the rejection over Blonder is proper in view of MPEP 2111.04 regarding "adapted to," "adapted for," "wherein," and "whereby" clauses. Initially, Applicants note that such clauses are not present in claim 31. To the contrary, claim 31 recites limitations using "configured to" with respect to the claimed engagement probe. In addition, MPEP 2111.04 states that the claim scope is not limited by claim language that does not limit a claim to a particular structure. However, the removable limitations of claim 31 absent from Blonder are clearly limited to a particular structure. As mentioned above, claim 31 recites the engagement probe is configured to removably penetrate a single conductive pad of the semiconductor substrate and to removably penetrate another single conductive pad of another semiconductor substrate. The recitation of "configured to" as opposed to "adapted to" or "adapted for" clearly limits a particular structure, i.e., the engagement probe is configured to removably penetrate. Further, Applicants note MPEP 2173.05(g) (8th ed., rev. 3) which provides that a functional limitation is an attempt to define something by what it does, rather than by what it is. However, the use of "configured to" in claim 31 defines the claimed configuration of the structure of the engagement probe. The limitations of claim 31 stating the engagement probe is configured to removably penetrate a single conductive pad of the semiconductor substrate and to removably penetrate another single conductive pad of another semiconductor substrate properly limit claim 31 to a particular structure. Furthermore, the

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forms of claim language of A-C of MPEP 2111.04 are not present in claim 31. Applicants respectfully submit the reliance upon MPEP 2111.04 by the Office in support of the non-consideration of the express limitations of claim 31 is improper inasmuch as the non-considered limitations limit the claim to a particular structure and do not include the express language recited in MPEP 2111.04. Even if the claim language of claim 31 is considered to recite functional language, MPEP 2173.05(g) (8th ed., rev. 3) provide that a functional limitation must be evaluated and considered just like any other limitation of the claim. The disclosed arrangements of Blonder regarding permanent connections fail to disclose or suggest the positively claimed structure of the engagement probe of claim 31 and the rejection of claim 31 is improper. Applicants respectfully request allowance of claim 31 in the next Action.

The claims which depend from independent claim 31 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 39 recites that the *knife-edge line includes an outer conductive layer*. The Office relies upon teachings in cols. 7-8 of Blonder in support of the 102 rejection. However, the identified teachings refer to the carrier pads and fail to teach or suggest the claimed outer conductive layer of the claimed knife-edge line. Applicants respectfully request withdrawal of the rejection of claim 39 for at least these compelling reasons.

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Claim 62 recites that the knife-edge line is sized and positioned to *extend elevationally above an uppermost surface of the apparatus substrate*. The Office states (with no identification of reference teachings) that the limitations of claim 62 are "within the operable scope of the apparatus disclosed by Blonder." Applicants respectfully reply that the positively-recited limitations of claim 62 are not disclosed nor suggested by the prior art and the 102 rejection of claim 62 is improper. The Office has recited no authority permitting the 102 rejection of claim 62 over prior art which fails to disclose or suggest the specifically-recited limitations of claim 62. Applicants respectfully request withdrawal of the rejection of claim 62 for at least these compelling reasons.

Referring to independent claim 77, Blonder fails to disclose or suggest limitations of the claimed electrical system. In particular, Blonder fails to disclose or suggest the claimed removable electrical interconnect apparatus *configured to removably engage the first and second electrically conductive pads* or the apparatus comprising the engagement probe comprising the apex configured to removably engage the first and second electrically conductive pads. The claim is properly limited to structure and the Office has recited no authority for disregarding the positively recited limitations which distinguish the claimed electrical system from the permanent connection teachings of Blonder. Claim 77 positively recites plural pads which are removably engaged by the single apparatus and single probe which are not taught by Blonder. Applicants respectfully request allowance of the claims for at least this reason.

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The claims which depend from independent claim 77 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 79, Blonder fails to disclose or suggest the claimed removable engagement probe comprising the apex in the form of a knife-edge line sized and positioned to removably engage the single conductive pad. The claimed limitations limit the claim to structure and such limitations are not disclosed by Blonder. Claim 79 is allowable for at least this reason.


The claims which depend from independent claim 79 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicants hereby add new claim 92 which is supported at least by Fig. 5 and the associated teachings of the originally filed specification.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 8/10/06

By: 
James D. Shaurette
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Webster's Third New International Dictionary

OF THE ENGLISH LANGUAGE
UNABRIDGED

A Merriam-Webster
REG. U.S. PAT. OFF.

WITH SEVEN LANGUAGE
DICTIONARY

VOLUME II

H to R



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